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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Siegfried Klapper

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EXAMINER

COOLEY, CHARLES E

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

05/25/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/583,563

Applicant(s)

KLAPPER ET AL.

Examiner

Charles E. Cooley

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 21 is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

FINAL OFFICE ACTION

1. **This application remains assigned to Technology Center 1700, Art Unit 1797 and the following will apply for this application:**

Please direct all written correspondence with the correct application serial number for this application to **Art Unit 1797**.

Telephone inquiries regarding this application should be directed to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 or to the Examiner at (571) 272-1139. All official facsimiles should be transmitted to the centralized fax receiving number 571-273-8300.

Priority

2. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Drawings

3. The replacement sheets of drawings filed on 5 APR 2010 are approved.

Specification

4. The substitute specification filed 19 JUN 2006 is approved.
5. The abstract is acceptable.
6. The title is acceptable.

Claim Rejections - 35 USC § 102

7. The terms used in this respect are given their broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art, in light of the written description in the specification, including the drawings, without reading into the claim any disclosed limitation or particular embodiment. See, e.g., *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989).

The Examiner interprets claims as broadly as reasonable in view of the specification, but does not read limitations from the specification into a claim. *Elekta Instr. S.A.v.O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14, 15, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahlstedt (US 2,628,023).

The patent to Dahlstedt discloses a device having a separator drum 1 for processing milk, where a measuring and control device 3-7 is provided which

determines a concentration of the fat content of an outflowing product phase from the separator (at 4) and when a defined or predetermined fat content limit value is reached or exceeded shifting a separation zone in a separator drum of the separator for a defined minimum time period by changing operating parameters obtained by throttling a valve 2. By throttling the valve 2, the separating zone in the separator drum is then shifted away for a certain period of time by consequently modifying the operating parameters which automatically and inherently prevents a blockage in the separator due to the increase in fat content above a known value. By means of the control of the fat content in the outflowing cream below a defined limiting value, a blockage is necessarily prevented and a threatened or potential blockage which also here is only known as a result of the determination of a fat content, is prevented by shifting the separating zone in the separator 1; wherein the fat-containing product is cold milk having an inlet to the drum at 1a and the cold milk is separated into cream (passing through an outlet proximate 4) and into skimmed milk (passing through an outlet proximate 3); wherein the separation zone in the drum 1 is shifted toward an interior of the drum when the fat content limit value has been one of reached and exceeded by throttling the valve 2; an analyzer 4 is arranged in the cream outlet by which analyzes the fat content of the cream; wherein the inlet proximate 1a extends from a bottom of the separator into a separator drum having a vertical axis of rotation as seen in the Figure. Relay 6, which controls the amount of time the valve 2 is throttled, is deemed equivalent to the recited timer.

Claim Rejections - 35 USC § 103

10. To determine whether subject matter would have been obvious, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966).

The Supreme Court has noted:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-41 (2007). "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." (Id. at 1742).

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlstedt (US 2,628,023) in view of GB 991500.

The Dahlstedt device discloses the analyzer 4 is connected with a control input of a throttling control valve 2 in the cream outlet for shifting the separation zone in the drum under control of a relay/timer 6 but does not disclose the valve in the skimmed milk outlet. GB 991500 discloses a separator wherein one of the outlets 37 of the separator 20 has a throttling valve. It would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the throttling valve of Dahlstedt on any of the outlets thereof for the purpose of varying the back pressure in said outlet to thereby shift the position of the separating zone in the separator (GB '500 at p. 3, lines 81-91).

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlstedt (US 2,628,023) in view of Gunnewig (US 4,755,165).

Dahlstedt does not disclose the analyzer connected to a device for controlling inflow rate. Gunnewig discloses a separator wherein an inflow rate of a material into the separator 1 through an inflow device 11, 20 is increased for a period of time via controller 18. It would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the device of Dahlstedt with a controlled inflow device for increasing an inflow rate of materials into the separator as taught by Gunnewig for the purpose of displacing the zone of separation within the separator to control the purity of the separated phases being discharged from the separator (col. 1, line 41 – col. 2, line 42 and col. 3, lines 21-44).

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlstedt (US 2,628,023) in view of Tenthoff (US 4,689,157).

Dahlstedt does not disclose the separator including a swirl space on a separating disk and a regulating disk having a diameter larger than a gripper chamber cover, which swirl disk, regulating disk and gripper chamber cover are arranged in a path to the skimmed milk outlet. Tenthoff discloses a separator 1 including a swirl space 9 on a separating disk and a regulating disk proximate 15 having a diameter larger than a gripper chamber cover 14, which swirl disk, regulating disk and gripper chamber cover are arranged in a path to the outlet 17. It would have been obvious and mere common

sense to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the device of Dahlstedt with a swirl space on a separating disk and a regulating disk having a diameter larger than a gripper chamber cover, which swirl disk, regulating disk and gripper chamber cover are arranged in a path to the outlet as disclosed by Tenthoff for the purpose of controlling the discharge of separated liquid from the separator (col. 3, lines 29-35).

Allowable Subject Matter

16. Method claims 1-13 and 21 are allowable over the prior art of record for the reasons set forth by Applicant in the remarks filed 5 APR 2010.

Response to Amendment

17. Applicant's arguments filed 5 APR 2010 have been fully considered but they are not deemed to be persuasive.

The examiner notes unamended device claims 14-20 are drawn exclusively to "a device" with an intended use of "for implementing the method of claim 1". Such an intended use has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641. The claim language ""for implementing the method of

claim 1" is merely a statement of intended use which imparts no structure to the claimed apparatus. It is well settled that the intended use of an apparatus is not germane to its patentability. *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982); *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967).

Since these unamended "device" claims do not recite any structure to distinguish over the prior art, the rejections from the last office action are repeated. The method claims stand allowed.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE

OF THIS FINAL ACTION. ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley in Art Unit 1797 whose telephone number is (571) 272-1139. The examiner can normally be reached on Monday - Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Additional assistance can be obtained via the Ombudsman Pilot Program is designed to enhance the USPTO's ability to assist applicants and/or their representatives with issues that arise during patent application prosecution. More specifically, if there is a breakdown in the normal prosecution process, the Ombudsman Pilot Program can assist in getting the process back on track. See <http://www.uspto.gov/patents/ombudsman.jsp> . If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles E. Cooley/

Charles E. Cooley
Primary Examiner
Art Unit 1797

21 May 2010